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Application Number

09/396,530

Filing Date

9/15/1999

First Named Inventor

Randall A. Addington

Art Unit

3711

Examiner Name

Piercve, William M.

Attorney Docket Number

99-1002

ENCLOSURES (Check all that apply)

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| <input type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> After Allowance Communication to TC |
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Remarks

Reply Brief
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Joel I. Rosenblatt, Patent Attorney

Signature

Printed name

Joell. Rosenblatt, Patent Attorney

Date

12/ /2004

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Application Number: 09/396,530

Group Art Unit: 3711

Filing Date: 9/15/99

Examiner Name: William Pierce

Inventors: Randall Addington et al.

Attorney Docket No.: 99-1002

Title: Method For Improving Bowler's Control

Assistant Commissioner of Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Appellants Response to Examiner's Answer 11/20/2004

NOTICE TO THE BOARD

November 29, 2001 was the date of first hearing of this appeal. The Board remanded February 7, 2002. Examiner's first answer to the remand was the Office action of June, 24, 2002. Applicants' Brief was filed 09/03/2002. A Notification of Non-Compliance was mailed 08/11/2004. Applicants' brief responsive to that Notice, was filed 08/25/2004.

1. Applicants stand on their Brief, with the addition of the following statements.
2. In the Answer, Section 5, page 2, (section number omitted in Answer), with respect to the Summary, examiner has improperly added arguments on the merits of patentability. Applicant stands on the Summary in the Brief, as adequately supported by the specification.

Applicant makes the following response with respect to examiner's comments on the Summary.
(See Answer, page 2.)

A) In Examiner in error, states there is a "pending New Matter Rejection." Answer, page 2, lines 8. There is no new matter rejection because all rejections under 35 USC 112, are dropped and the sole issue is patentability under 35 USC 102. The Office action 06/24/2002, stated,

[T]o satisfy the Board's Concerns, . . . dropping all issues under 35 USC 112.

(See Final Rejection, mailed 06/24/2002, Confirmation No. 7581, page 2, paragraphs numbered “3,” and see also “4a,” lines 9-16.)

B) Examiner in error stated Applicant has discussed

“...during the upswing the hand naturally will have a tendency to rotate so that the thumb reverses its position so that it is facing downward at the end of delivery.”

(See Answer, page 2, lines 8-10.)

C) Examiner’s statement,

Hence, the main position of the Examiner is that Appellants finger protector functions inherently as any other finger protector known [sic] in the art to improve grip, support the fingers and transmit the forces between the fingers and the ball during delivery of the ball down the alley,

(See Answer, page 2, lines 15-17),

is examiner’s argument that should be limited to the Grounds Of Rejection. Applicants have responded to examiner’s grounds for rejection in the Brief and as stated below.

3. Applicant concurs with examiner that “. . . appellant’s statement of the issues in the brief is correct.” That statement of the issues is,

VI. Issues

Whether rejection of claims 3, 4, and 14 - 30 under 35 U.S.C. 102(b) as anticipated by Marinese et al. (See Final Rejection mailed 6/24/2002. page 3) should be overruled.

(See Answer, page 2, lines 25, 26.)

4. The Answer, Section 10, starting on page 3, line 6, and continuing to the penultimate line of page 5 Grounds of Rejection, repeats the grounds of examiner’s Final Rejection, mailed 06/14/2002. No response is made thereto, except for the following response, by way of a restatement of the Rule 132 Declaration of Dr. W. Robert Addington, DO, a co inventor, a Board Certified Physician in Rehabilitation Medicine and an expert in muscular skeletal medicine, that,

In the sport of bowling, a bowler will choose a ball suitable to that bowler’s muscular skeletal development and within the limited weight allowed by bowling authorities such as the American Bowling Congress. While a stronger bowler at the upper end of the

limit of muscular skeletal development, may prefer a heavier ball, the force applied from the bowling ball to the finger pad will be limited by the maximum weight of a bowling and the maximum force which can be applied to the bowling ball within a limit of muscular skeletal development.

There is a limit to muscular skeletal development and a maximum force with respect to the limit of that muscular development. The recited claims would be understood by one skilled in the art of bowling and bowling devices, at the time this application was filed, as a bowler's maximum force within that limit of muscular skeletal development applied to the ball to lift the ball at its release.

(See Brief, page 3)

Examiner's assessment of Dr. Addington's Declaration, that,

... it was subjective in its interpretation and failed to set forth facts,

(See Answer, page 5, lines 23-26),

has no support in law or fact, is the subjective opinion of examiner and must be disregarded. Dr. Addington has demonstrated he is an expert in muscular skeletal development. Examiner has shown no facts in support of his stated position. Examiner has shown no background, education, or experience, or qualifications, to assess or judge Dr. Addington's Declaration or qualifications to rebut or refute Dr. Addington's Declaration..

5. Applicants make no response to Section 11, Response to Arguments, except for the following.

A) Argument NO. 2, is irrelevant to the appeal. There is no argument made for the drawings.

Advisory Action, 8/16/2002, approved the drawing correction and stated

[A]pplicant's reply has overcome the following rejections: objections to drawings.

B) Applicants' remarks made above, in support of the Addington Declaration, are restated in response to examiner's statements made on page 10, lines 21-25, and on page 11, lines, 18-21, and page 12, lines 1-4, regarding the Dr. Addington Declaration.

Respectfully,

 12/20/01

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